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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/918,174

07/30/2001

Xiaobao X. Chen

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2207

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04/15/2005

Docket Administrator (Room 3J-219)
Lucent Technologies Inc.
101 Crawfords Corner Road
Holmdel, NJ 07733-3030

EXAMINER

KADING, JOSHUA A

ART UNIT

PAPER NUMBER

2661

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,174

Applicant(s)

CHEN, XIAOBAO X.

Examiner

Joshua Kading

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 1 and 5-8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-16-03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

Claims 1 and 5-8 are objected to because of the following informalities:

Regarding claim 1, line 7, "the packet" and "the source" should be changed to --a
5 packet-- and --a source-- respectively to avoid a lack of antecedent basis.

Regarding claim 1, line 8, "the destination" should be changed to --a destination--
to avoid a lack of antecedent basis.

Regarding claim 5, line 2, "of correspondent" should be changed to --of the
correspondent--.

10 Regarding claim 5, line 5 and claim 7, lines 4-5, "said information" should be
changed to --said record-- because it lacks proper antecedent basis.

Regarding claim 6, lines 2-3 and claim 8, line 2, "the stored information" should
be changed to --the stored record-- to be consistent with the prior claim language.

Regarding claim 6, line 4, "the correspondent node home address" should be
15 changed to --a home address of the correspondent node-- to avoid a lack of antecedent
basis.

Regarding claim 8, line 2, "the foreign" should be changed to --a foreign-- to
avoid a lack of antecedent basis.

Regarding claim 8, lines 3-4, "the mobile node home address" should be
20 changed to --a home address of the mobile node-- to avoid a lack of antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- 5 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
10 only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent 6,501,746 B1, Leung.

15

Regarding claim 1, Leung discloses, "a method of operating a third generation mobile telecommunications system, in which packets are addressed to a mobile node which is currently associated with a foreign network and is communicating with a correspondent node (*figure 1*), comprising the steps of: setting up a home agent in the
20 correspondent node (*figure 1, element 8 where element 8 acts as a correspondent node because it is in communication with the mobile node and thus corresponding with the mobile node*) and allocating a Care of Address for the mobile node (*figure 2, element 208*); and changing a packet header so that a source address is the home agent address, a destination address is the Care of Address (*figure 2, elements 226 and 228*
25 *where the source address will be that of the HA because that is where the packet is coming from*), and the header further includes a correspondent node identifier code and a mobile node identifier code (*figure 2, element 226*)."

Regarding claim 2, Leung discloses, "a method according to Claim 1 in which the Care of Address is the address of the mobile node (*col. 6, lines 61-64*)."

5 Regarding claim 3, Leung discloses, "a method according to Claim 1 in which the Care of Address is the address of a foreign agent in the foreign network (*col. 2, lines 40-42*)."

10 Regarding claim 4, Leung discloses, "a method according to claim 1 in which the packet header is changed by the home agent (*figure 2, element 226*)."

15 Regarding claim 5, Leung discloses, "a method according to claim 4 comprising the further steps of: the home agent retaining a record of the correspondent node and correspondent node identifier codes (*figure 7, element 702 as read in col. 10, lines 58-61*); and the home agent sending a copy of said record to the destination address in the Care of Address at which said record is also stored (*figure 2, element 230 as read in col. 8, lines 5-7 and 19-20*)."

20 Regarding claim 6, Leung discloses, "a method according to Claim 5 in which when a packet arrives at the destination address in the Care of Address, the destination checks the stored record and replaces the correspondent node identifier code in the header with a home address of the correspondent node (*col. 16, lines 52-60*)."

Regarding claim 7, Leung discloses, "a method according to claim 1 comprising the further steps of: the home agent retaining a record of the mobile node and mobile node identifier code (*figure 7, element 702, col. 10, lines 58-61*); and sending a copy of said record to the Care of Address at which said record is also stored (*figure 2, element 230 as read in col. 8, lines 5-7 and 19-20*)."

Regarding claim 8, Leung discloses, "a method according to Claim 7 in which, when the packets arrive at the Care of Address, a foreign agent checks the stored record and replaces the mobile node identifier code in the header with a home address of the mobile node (*col. 16, lines 52-60*)."

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 1, 6, 7, 8, and 7 respectively of U.S. Patent No. U.S. Patent 6,829,483 B2, Chen. Although the conflicting claims are not identical, they are not patentably distinct from each other because Chen discloses a

5 narrower version of what is disclosed in the instant application (specifically claim 1).


Chen further adds the "sending a QoS enquiry message...and sending a QoS response." Although the sending of QoS enquiry and response messages is not disclosed in the independent claim of the instant application, it would have been obvious to one of ordinary skill in the art at the time of invention to not include the enquiry and

10 response messages because they are not necessary for the invention as disclosed in the instant application to work. That is to say, the invention in the instant application and the invention in Chen are directed to the same underlying subject matter and the adding of QoS enquiry and response messages only adds additional functionality to the invention in Chen, it does not change the way the core invention works. The motivation
15 for not using a QoS scheme would be to not waste time and resources reserving a path (which might not even be available) that is needed to satisfy the QoS requirements (*Chen, col. 3, lines 60-63 where there is added complexity by the use of RSVP*).

Any inquiry concerning this communication or earlier communications from the
20 examiner should be directed to Joshua Kading whose telephone number is (571) 272-3070. The examiner can normally be reached on M-F: 8:30AM-5PM.

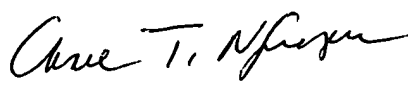
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (571) 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

- Information regarding the status of an application may be obtained from the
- 5 Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic
- 10 Business Center (EBC) at 866-217-9197 (toll-free).



Joshua Kading
Examiner
Art Unit 2661

April 7, 2005



CHAU NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600